

R E M A R K S

- Claims 3, 6-9, 12-25, 34, 38, 39, 42-45, 50, 51, 55, and 57-61 are pending
- Claims 3, 6-9, 12-25, 34, 38, 39, 42-45, 50, 51, 55, and 57-61 are rejected
- Claims 3, 9, 15, 20, 34, 38, 42-45, 50-51, 55 and 57 – 61 are the only independent claims

A. Telephone Interview

We would like to thank Examiner Havan for the helpful telephone conversation held on May 17, 2005, with our representative.

Examiner Havan and our representative discussed the present application in light of the Boyer and Pickering references.

Our representative stated that the references do not teach or suggest a reimbursement rule that is associated with a credit card account, as recited in Claim 57.

The Examiner indicated that an additional search would be performed for the pending claims.

While no formal agreement was reached with respect to patentability, we are grateful for the opportunity to discuss the present application with Examiner Havan.

B. Request for Withdrawal of the Present Office Action

The present Office Action (authored by former Examiner Wasylchak) suffers from several deficiencies. The Office Action does not address the claims as currently pending. The Office Action is unclear as to grounds of rejection. We respectfully request withdrawal of the present Office Action and reconsideration of the pending claims.

B.1. Section 102(b) or Section 103(a) Over Boyer?

On page 2, the former Examiner introduces a rejection under Section 102(b) and then states that Claims 3, 6-9, 12-25, 34, 38, 39, 42-45, 50, 51, and 55 are rejected under Section 103(a) over Boyer. The grounds of rejection are unclear.

B.2. Claims Were Examined as Originally Filed (Not as Pending)

With respect to at least Claims 3, 6-9, 12-25, 34, 38, 39, 42-45, 50, 51, and 55, former Examiner Wasylchak appears to have simply copied that Examiner's earlier remarks from the Office Action mailed November 14, 2002. As discussed in our Response mailed March 18, 2003, the remarks of the former Examiner are clearly directed to the text of those claims as originally filed, not as currently pending. In this Office Action, the former Examiner again chose to ignore new language introduced in THREE amendments to those claims.

B.3. Discussions of Claims 3, 6-8 and 55 are Incomplete

In addition, the former Examiner's discussion of Claim 3 is incomplete in that it does not even address all of the features as originally filed. [Office Action, page 2]. The discussions of Claims 6-8 and 55 depend on the incomplete discussion of Claim 3 and are thus incomplete also.

C. Section 102(b) Rejection over Boyer

Claims 3, 6-9, 12-25, 34, 38, 39, 42-45, 50, 51, and 55 appear to stand rejected under 35 U.S.C. 102(b) over U.S. Patent No. 6,208,973 issued to Boyer et al. ("Boyer"). We respectfully traverse the former Examiner's Section 102(b) rejections.

C.1. Independent Claims 3, 9, 15, 20, 34, 38, 42 – 45, 50, 51, and 55

The former Examiner apparently asserts that Boyer discloses all of the features of each of independent Claims 3, 9, 15, 20, 34, 38, 42 – 45, 50, 51, and 55. We respectfully traverse this assertion.

We have carefully reviewed the Boyer reference cited by the former Examiner, including the particular indicated sections, without finding a teaching or suggestion of *a reimbursement rule that specifies a second merchant*, much less *determining whether a first merchant indicated by charge data corresponds to the second merchant*, as generally recited in independent Claims 3, 9, 15, 20, 34, 38, 42 – 45, 50, 51, and 55.

Boyer does not teach or suggest charge data that indicates a first merchant, or a reimbursement rule specifying a second merchant, much less determining whether charge data satisfies a reimbursement rule based on whether a first merchant corresponds to a second merchant.

We respectfully submit that Boyer does not disclose all of the limitations of any of independent Claims **3, 9, 15, 20, 34, 38, 42 – 45, 50, 51, and 55**. Each of Claims **6-9, 12-14, 18-19, 22, and 39** is dependent from one of independent Claims **3, 9, 15, 20, and 38**, and is believed to be allowable for at least the reasons stated herein with respect to the independent Claims **3, 9, 15, 20, and 38**.

Accordingly, we respectfully submit that the former Examiner has failed to establish a *prima facie* case of anticipation of any of Claims **3, 6-9, 12-15, 18-20, 22, 34, 38-39, 42-45, 50-51, and 55**.

C.2. Independent Claims 15 and 42 – 43

In addition to the features discussed above, we respectfully submit that Boyer is devoid of a hint or suggestion of *apportioning a transaction amount among a plurality of financial accounts*, in which each financial account is associated with a respective reimbursing party.

We have carefully reviewed the Boyer reference cited by the former Examiner, including the particular cited sections, without finding a teaching or suggestion of such a feature. At the cited sections, Boyer describes only "the first portion of the payment to be paid by the third party payor." [Column 3, lines 39 – 56; Column 4, lines 37 – 48.] There is no hint or suggestion that more than one reimbursing party may be apportioned any of the transaction amount. Accordingly, Boyer does not teach or suggest apportioning the transaction amount among a plurality of financial accounts, each financial account being associated with a respective reimbursing party, as provided for in independent Claims **15 and 42 - 43**.

We respectfully submit that Boyer does not disclose all of the limitations of any of independent Claims **15 and 42 – 43** (or any claims dependent from them). Accordingly, we respectfully submit that the former Examiner has failed to establish a *prima facie* case of anticipation of any of Claims **15, 18-19, and 42-43**.

C.3. Claim 6, 7, 13 and 14

The former Examiner appears to assert that Boyer discloses all of the features of each of dependent Claims **6, 7, 13 and 14**. We respectfully traverse this assertion.

Some embodiments of the present invention provide for determining whether any reimbursing parties have not paid the amounts they were charged. The unpaid amount may then be charged to the corresponding account holder. [See, e.g., Specification, page 27, lines 15 - 23.] Thus, the account holder may be

liable, after a predetermined time, for the entire transaction amount (or at least an amount that may have initially been apportioned to a reimbursing party).

Claims **6 and 13** each provide for applying the same charge amount to both (i) the financial account of the reimbursing party, and (ii) at least one account of the account holder (after a predetermined time).

We respectfully submit that Boyer is devoid of a hint or suggestion of applying to at least one of the credit card account and the debit card account a charge amount after a predetermined time after a transaction date.

We have carefully reviewed the Boyer reference cited by the former Examiner, including the particular indicated sections, without finding a teaching or suggestion of such features. Contrary to the former Examiner's assertion, Boyer is devoid of any hint or suggestion of "applying to the first financial account the second charge amount after a predetermined time after the transaction date." [Office Action, page 3.] The cited portion of Boyer merely describes problems experienced by healthcare providers because of an inability by the healthcare providers to determine the patient payment amount at the time of service, and the necessity of billing patients while also submitting claims to third party payors for adjudication. [Column 1, lines 16 – 61.]

In contrast, Claims **6 and 13** are directed to methods in which an amount to be charged to a reimbursing party is determined, and in which the same charge amount applied to the reimbursing party may also be applied to at least one account of the account holder after a predetermined time. Further, Claims **7 and 14** provide for wherein the charge amount is applied if the charge amount has not been paid before a predetermined time. There is nothing in Boyer that describes or suggests a need for applying a charge amount to an account holder's account, in which the same charge amount was also applied to a reimbursing party's financial account.

We respectfully submit that Boyer does not disclose all of the limitations of any of Claims **6, 7, 13 and 14**. Accordingly, we respectfully submit that the former Examiner has failed to establish a *prima facie* case of anticipation of any of Claims **6, 7, 13 and 14**.

D. Section 102(b) Rejection over Pickering

Independent Claims **57-61** stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,684,965 issued to Pickering ("Pickering"). We respectfully traverse the former Examiner's Section 102(b) rejections.

Pickering does not teach or suggest applying the same charge amount to a financial account of an account holder that was billed to a financial account of a reimbursing party, much less applying such a charge amount if the reimbursement party has not remitted a payment for the second charge amount within a predetermined period of time.

Also, Pickering does not teach or suggest determining a reimbursement rule that is associated with a credit card account or debit card account, much less wherein a reimbursing party may be billed for at least a portion of a transaction amount charged to such accounts.

Pickering also does not teach or suggest any of the following:

- transmitting to the reimbursing party a billing statement for the financial account of the reimbursing party,
 - in which the billing statement includes an indication of the second charge amount
- determining whether the reimbursing party has remitted a payment of the second charge amount within a predetermined period of time
- applying the second charge amount to the financial account of the account holder if the reimbursing party has not remitted a payment of the second charge amount within the predetermined period of time

as generally provided in new independent Claims **57 - 61**. Nothing in the portions of Pickering cited by the Examiner (or elsewhere in Pickering) teaches or suggests any of the above.

Independent Claims **57 – 60** each provide for determining a reimbursement rule that is associated with a credit card or a debit card account, in which the reimbursement rule indicates a period of time for the reimbursing party to remit payment. Pickering does not teach or suggest such a feature.

Further, independent Claims **59 and 60** each provide for determining whether the charge data satisfies the reimbursement rule based on the reimbursement condition and the indication of a category of merchant. Pickering does not teach or suggest such a feature.

We respectfully submit that the former Examiner has failed to establish a *prima facie* case of anticipation of Claims **57-61** and we respectfully submit that Claims **57-61** contain allowable subject matter.

E. Authorization to Charge Appropriate Fees

We do not believe that any fees are necessary for this response.

Please grant a petition for any extension of time required to make this Response timely.

If necessary, please charge any appropriate fees necessary per the following information:

Deposit Account: 50-0271

Order No.: 98-017

Please credit any overpayment to the same account.

A duplicate copy of this authorization is enclosed for such purposes.

F. Conclusion


For at least the reasons stated herein, we respectfully request allowance of the pending Claims **3, 6-9, 12-25, 34, 38, 39, 42-45, 50, 51, 55, and 57-61**. The former Examiner has failed to establish a *prima facie* case of anticipation of any pending claim. It is submitted that all of the claims are in condition for allowance. Examiner Havan's early re-examination and reconsideration are respectfully requested.

If Examiner Havan has any questions regarding the present application, please contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

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Date


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